

## REMARKS

This Amendment is responsive to the final Office Action mailed August 24, 2006. New claim 78 is presented herewith.

**I. IDS submitted with the application on 8/17/01 is proper and *must* be considered**

The form PTO-1449 submitted with the original application on August 17, 2001, is in FULL compliance with 37 C.F.R. §1.98(a)(1), which requires the following:

- 1) *A list of all patents, publications, applications, or other information submitted for consideration by the Office.* The PTO-1449 included a list of all patents (foreign and US) and other information (non-patent references).
- 2) *U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents.* In the 1449 of 8/17/01, the US patents were listed separately, as were the non-US patents, as were the non-patent references. The patents were listed in a separate and distinct section, followed by the non-US patent references in their own separate and distinct section, followed by the non-patent references in their own separate and distinct section.
- 3) *The application number of the application in which the information disclosure statement is being submitted on each page of the list.* As this IDS was submitted along with the application on 8/17/01, no application number existed, so it was not possible to note the application number. On the top of the 1449, note the heading: "Application No.: To Be Assigned"
- 4) *A column that provides a blank space next to each document to be considered, for the Examiner's initials.* The PTO 1449 specifically included a column labeled "Exr. Initials" in each table; that is, in the U.S. patent Documents table, the Foreign Patent or Foreign Patent Application table, and in the non-patent reference section.
- 5) *A heading that clearly indicates that the list is an information disclosure statement.* Note the title of the PTO-1449 attached to the IDS of 8/17/01: Form 1449 (Modified) **Information Disclosure Statement by Applicant** (use Several Sheets if Necessary).

The IDS submitted by Applicants on August 17, 2001, clearly satisfies each of the requirements of C.F.R. §1.98(a)(1), and must be considered by the Office. Applicants submit herewith, as **Exhibit A**, a marked up copy of the modified form PTO-1449, as filed on August 17, 2001, identifying each of the above requirements. Applicants also submit herewith, as **Exhibit B**, copies of the *Information Disclosure Statement* and *modified form PTO-1449* as filed

with the original application in full compliance with 37 C.F.R. §1.98(a)(1), on August 17, 2001, and the *PTO stamped return postcard* acknowledging receipt of same. It should be noted that the IDS and the modified form PTO-1449 are separate papers.

It is respectfully submitted that the Office erred in not considering the IDS filed August 17, 2001. It is also respectfully requested that the Office remedy its past error now and consider the references that were timely and properly cited and submitted.

## **II. Objection to Claim 1**

Claim 1 has been amended to address the Examiner's well taken objection. Applicants' representative thanks the Examiner for his attention to detail in this regard.

## **III. 35 U.S.C. §112(1) Rejection**

Claim 1 was rejected under 35 U.S.C. §112(1) as allegedly failing to comply with the written description requirement. In essence, the Office argues that Applicants do not disclose an unchanged signal, and has interpreted claim 1 as if "unchanged" were "uninterrupted." Reconsideration and withdrawal of this rejection is respectfully requested.

The Examiner's attention is drawn to page 16, lines 8-15 of the specification:

The digital bus 128 is preferably provided directly between the input mux 126 and the output mux 168, as shown. In effect, this digital AV bus 128 provides an uninterrupted path for a digital video stream from the input 102 to the output 109, to thereby provide the ability to render a video stream in full screen mode without any degradation in picture quality (i.e., without degradation of the signal-to-noise (S/N) ratio). Indeed, as the video stream may traverse the entire interactive TV device without perturbations (without needing to propagate through an intervening device), the present interactive TV device is functionally invisible within the context of full screen viewing.

The specification, therefore, tells us that the digital bus 128 is provided directly between the input mux 126 and the output mux 168, provides an uninterrupted path from the input 102 to



bus to the output” is to flatly ignore both the written portion of the specification as well as the drawings portion thereof. It is respectfully submitted that the Office is not at liberty to simply decide, *sua sponte*, to substitute one term (uninterrupted) for another (unchanged) for the purposes of examination. Reconsideration and withdrawal of the 35 U.S.C. §112(1) rejection of claim 1 is, therefore, respectfully requested.

#### IV. 35 U.S.C. §102(e) Rejections

Claims 1-3, 10-16, 24 and 37, are rejected under 35 U.S.C. §102(e) as being anticipated by D’Luna et al. (20020106018). Reconsideration and withdrawal of these rejections are respectfully requested.

D’Luna does not teach claim 1, as amended:

**an input, the input being configured to accept a plurality of input streams;**

**an output, the output being configured to selectively output a plurality of output streams;**

**a first digital bus coupled between the input and output, the first digital bus being uninterrupted between the input and the output such that a digital signal presented at the input is carried unchanged over the first digital bus to the output;**

On page 2, lines 3-5 of the outstanding final Office Action, the Examiner points to Fig.2 of D’Luna, and states: “Elements 124 and 104 are directly coupled to each other, and the signal is sent between the two without broken continuity.”

In this regard, kindly note D’Luna’s Fig. 2, reproduced below with the Input and Output clearly marked for the Examiner’s reference:

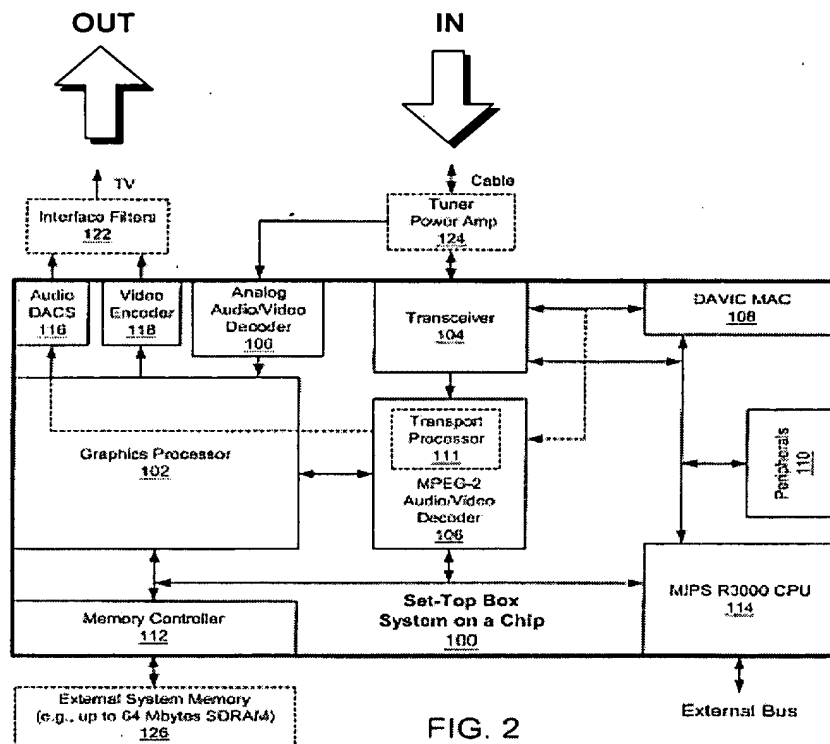


FIG. 2

Note that the input to the “Single Chip Set-Top Box System” of D’Luna’s Fig. 2 (Cable In) and the output to the chip (TV Out). Now, the Examiner’s attention is respectfully drawn to amended claim 1, which recites:

an input, the input being configured to accept a plurality of input streams;  
 an output, the output being configured to selectively output a plurality of output streams;  
 a first digital bus coupled between the input and output, the first digital bus being uninterrupted between the input and the output such that a digital signal presented at the input is carried unchanged over the first digital bus to the output;

Therefore, the first digital bus is specifically recited to be “coupled between the input and the output” (of the claimed interactive TV device), “such that a digital signal presented at the input of is carried unchanged over the first digital bus to the output.” Such is clearly NOT the case in D’Luna. Contrary to what is asserted by the Office, that the “Elements 124 and 104 are directly coupled to each other, and the signal is sent between the two without broken continuity,”

is not probative and does not meet the requirements of claim 1. Element 124 is clearly the input to the disclosed single chip set-top box system, but element 104 most definitely is NOT its output. Therefore, Fig. 2 of D'Luna does not teach the claimed embodiment.

In D'Luna, a digital signal presented at the input is NOT "carried unchanged over the first digital bus to the output," as required by the claim. In D'Luna, the digital signal presented at the input (Tuner Power Amp 124) is first presented to the Transceiver 104 (which is not the output of the system), whereupon, the signal is sent to the Transport Processor 111 / MPEG 2 Audio/Video Decoder 106, and thereafter to the Graphics Processor 102, to the Audio DACS 116 for the sound and to the Video Encoder 118 for the picture, whereupon such signals are filtered at 122 before being output to the TV, which constitutes the output of the D'Luna device. Any analog signal presented at the input is sent to the Analog Audio/Video Decoder 106 and thereafter to the Graphics Processor 102 and back out through the DACS 116 and the Video Encoder 118 and filters 122.

As can be seen, D'Luna undeniably does not teach that a digital signal presented at the input is carried unchanged over the first digital bus to the output, as required by the claim. Such a digital input signal, in D'Luna is at least decoded at 106, transported at 111, processed at 102, converted at 116, encoded at 118 and filtered at 122 before reaching the output at 122. In view of these serial transformations of the digital signal in D'Luna, it is certainly demonstrably accurate to characterize the digital input signal in D'Luna as being changed. In direct contrast, the claimed embodiment specifies that the digital signal presented at the input is carried unchanged over the first digital bus to the output, which is clearly and unambiguously shown in Fig. 1, as the bus 128 carries the digital signal unchanged from the input IN 102 to the output OUT 109.

In this regard, it is respectfully submitted that the Office is not at liberty to call element 104 the "output." Element 104 is not the output of the D'Luna system, it is a transceiver that is the gateway input element to D'Luna's device. Therefore, that a digital signal is carried unchanged between elements 124 and 104 (a statement on which the undersigned has no position or opinion), as advanced by the Office, is of no consequence to claim 1, which requires that the digital signal be carried unchanged from the recited input of the claimed device to the recited output of the claimed device.

The Office's own standards for anticipation under §102 of the patent statute, as set forth in the MPEP, are set forth below:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. § 102 rejection. See MPEP § 2131.01.

Anticipation, therefore, can only be established only if each and every element recited in the claims is found in the applied reference. Therefore, unless D'Luna teaches an interactive TV system that includes "a first digital bus coupled between the input and output, the first digital bus being uninterrupted between the input and the output such that a digital signal presented at the input is carried unchanged over the first digital bus to the output," as claimed, the §102(e) rejections must be withdrawn. The same is, therefore, respectfully requested.

#### V. 35 U.S.C. §103(a) Rejections

The Examiner's reliance upon inherency is misplaced, in error and does not conform to the USPTO's own standards concerning inherency.

The MPEP sets forth strict guidelines for the use of Official Notice, which the Office has not adhered to in the present case. In support of the rejection of claims 4, 5, 6, 7, 8, 9, 23, 27, 28, 33 and 34, the Office has relied upon the use of Official Notice. The applicant traverses such Official Notices on the following grounds:

**It is never appropriate to rely solely on Official Notice as the principal evidence upon which a rejection is based**

It is noted that the sole ground for rejecting each of these dependent claims is the Official Notice. The Office, however, is respectfully reminded of the unambiguous guidance provided by the PTO's own MPEP in §2144.03:

**Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421. (Emphasis Added).**

Note the unambiguous statement of the MPEP above:

**It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. (Italics Added)**

Official Notice was not used in claims 4, 5, 6, 7, 8, 9, 23, 27, 28, 33 and 34 to "fill in the gaps" in an "insubstantial manner." Instead, Official Notice is the sole grounds for rejecting each of the claims. In each case, the Examiner acknowledges that the claimed structure or feature is not taught in the applied reference and relies upon an injudicious, informal and backdoor Official Notice that the missing structure or feature was "notoriously well known." Here, the Office has relied solely on common knowledge in the art without evidentiary support in the record as the principal and only evidence upon which the rejections are based, which is clearly forbidden both by the *Ahlert* and *Zurko* courts and the Patent Office's own MPEP.



It is respectfully submitted that Applicants will not "specifically point out the errors in the Examiner's actions," as requested by the final Office Action on page 2, paragraph (a). Doing so could unnecessarily create estoppel issues in attempting to respond to a rejection which is clearly inadequate on its face, as a matter of law, and as a matter of the USPTO's own guidelines. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. Neither the courts nor the USPTO's own guide for the examination of patent applications allow for any wriggle room. The Office's §103(a) rejections based solely upon Official Notice must be withdrawn. The same is, therefore, respectfully requested.

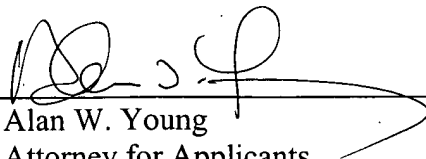
As amended claim 1 has been distinguished from D'Luna and the anticipation rejection overcome, it is respectfully submitted that this application is in condition for allowance.

If any unresolved issues remain, please contact the undersigned attorney of record at the telephone number indicated below and whatever is necessary to resolve such issues will be done at once.

Respectfully submitted,

Date: March 5, 2007

By: \_\_\_\_\_

  
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